

REMARKS

In the Final Office Action, claims 18-21, 52-59, 68, 69, 92-95, 124-128, 130, 131, 142, 143, 165-168, 195-199, 201, 202, 213, and 214 were withdrawn from consideration. Since, as will be explained below, all of the independent claims 1, 71, and 144 are allowable, Applicant requests rejoinder and allowance of the withdrawn claims.

Applicant thanks the Examiner for withdrawing the rejections set forth in the Office Action mailed February 27, 2004.

In the Final Office Action, all of the examined claims (claims 1, 3-9, 11-17, 22-51, 60-67, 70-83, 85-91, 96-108, 110, 112-116, 118-121, 123, 132, 133, 135-141, 144-156, 158-164, 169-182, 184-192, 194, 203, 204, and 206-212) were newly rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,519,795 to Hitchcock, Jr. et al. ("Hitchcock") in view of U.S. Patent No. 4,594,835 to Gray. The Section 103 rejection based on the combination of Hitchcock and Gray is the sole rejection in the Final Office Action.

Each of independent claims 1, 71, and 144 recites a device comprising, among other things, an "application member . . . at least partially compressed inside the substantially closed reservoir" when the device is in a closed position.

Hitchcock discloses a disposable swab for application of medicament and the like to skin. Referring to Figs. 1-3, Hitchcock discloses a disposable swab 10 comprising a flat sheet-like strip 12. A pad member 14 may comprise polyester sponge material or any other absorbent pad-like material as may be desired for use, secured by adhesive or heat sealing to the foil face 16 of the flat, sheet-like strip 12. (See col. 3, lines 22-26). Hitchcock discloses that pad member 14 is impregnated with a medicament and the

like. (See col. 3, lines 26-27). Opposed terminal portions 20 of strip 12 may be folded rearwardly relative to pad 4, as shown in FIGS. 3 and 4, and pinched by the fingers together into flat, abutting relation to serve as a finger-grippable handle portion, for holding the disposable swab during the swabbing process. (See col. 3, lines 36-43)

Hitchcock further discloses that the pad member 14 is enclosed in a frangible pouch 32 to completely enclose the pad 14. (See col. 3, lines 51-55). A conventional tear tab 34 may be provided for easy manual tearing removal of frangible pouch 32 for exposure of the pad 14. Thereafter, swab 10 may be used, transferring the impregnated medicament stored in the pad 14 to the skin. The swab may then be disposed of. (See col. 3, lines 55-60). Hitchcock contains no disclosure that medicament is placed in the pouch 32, other than that medicament with which the pad member 14 is impregnated.

Gray discloses a method for making sachets having a pocket (5 in Fig. 2) in a sheet of film or foil. The method includes placing a measured amount of liquid into the pocket (see col. 1, lines 63-66 and col. 2, lines 56-58) and placing a carrier (10 in Fig. 2) into the pocket. A second film or foil (1 in Fig. 2) is then placed over the pocket containing the liquid and carrier and the second film is sealed to the pocket in such a manner so as to compress the carrier in the pocket. In use, Gray discloses that upon opening the sachet, the carrier resumes its original size and takes up further quantities of liquid from the pocket. (See col. 2, lines 7-9 and col. 3, lines 4-7.)

In the Final Office Action, the Examiner recognizes that the "Hitchcock, Jr. et al. reference does not specifically disclose that when the device [is] in a closed position,

the application member is at least partially compressed inside the reservoir.” To cure this acknowledged deficiency of Hitchcock, the Examiner relies on Gray, asserting that

it would have been obvious to one of ordinary skill in the art at the time the invention was made to compress the application member in the reservoir of Hitchcock, Jr. et al device in view of the teaching of the Gray reference for allowing the application member to take all product inside the reservoir when it expands to the uncompressed state upon withdrawal from the open reservoir.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, three basic criteria must be satisfied. First, “there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings.”

M.P.E.P. § 2143. “Second, there must be a reasonable expectation of success.” Id. Third, “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” Moreover, when a proposed modification changes the principles of operation explicitly taught in a reference, such a modification is insufficient to render the claims *prima facie* obvious. See M.P.E.P. § 2143.01.

The rejection based on the combination of Hitchcock and Gray set forth in the Final Office Action is improper and should be withdrawn because a *prima facie* case of obviousness has not been established. In particular, to modify Hitchcock with the teachings of Gray in the hypothetical manner suggested in the Final Office Action would destroy the explicit teachings and principle of operation of the Hitchcock device. This is because, as discussed above, Hitchcock explicitly teaches a device wherein the swab 10 is impregnated with medicament **prior** to placing it in the pouch 32. To compress the swab 10 of the Hitchcock device in the pouch 32, as suggested in the final Office

Action, would cause medicament to be expelled from the swab 10, in which case the swab 10 would no longer be impregnated. Such expelling of medicament from the swab 10 via compression in the pouch 32 goes against the explicit teachings of Hitchcock to provide an impregnated swab 10 in the pouch 32.

Moreover, Hitchcock does not disclose filling the pouch 32 with the medicament prior to placement of the swab 10 in the pouch 32. Instead, Hitchcock explicitly teaches impregnating the swab 10, and not pouch 32, with the medicament, and then placing the impregnated swab 10 in the pouch 32. And Gray explicitly teaches **not** to impregnate the carrier 10 prior to placing it in the pocket 5, but rather teaches to fill the pocket 5 and then place and compress the carrier 10 in the pocket 5. (Gray, col. 2, lines 36-43.)

Thus, skilled artisans would not have been motivated to modify the Hitchcock device with the teachings of Gray in the manner suggested by the Examiner since Hitchcock and Gray teach exactly opposite methods and therefore teach against the hypothetical modification suggested by the Examiner. In other words, skilled artisans would not have turned to Gray to modify Hitchcock because the principle of operation of Gray relies on a carrier that is **not** impregnated prior to sealing and compressing the carrier in the sachet, whereas the principle of operation of the device taught by Hitchcock requires impregnation of the swab 10 prior to placing it in the pouch 32 and while it is in the pouch 32. The modification proposed in the Final Office Action changes the principles of operation explicitly taught in both Hitchcock and Gray, and as such insufficient to render the claims *prima facie* obvious. See M.P.E.P. § 2143.01.

For the above reasons, Applicant requests the withdrawal of the claim rejections, the rejoinder of the withdrawn claims, and the allowance of pending claims 1, 3-9, 11-83, 85-108, 110, 112-116, 118-121, 123-128, 130-133, 135-156, 158-182, 184-192, 194-199, 201-204, and 206-214.

Please grant any extensions of time required to enter this response and charge any required fees not otherwise accounted for to our Deposit Account 06-0916.

Respectfully submitted,

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